REMARKS

The present invention relates to an improved chemical-mechanical polishing (CMP) slurry composition. Claims 1-36 are currently pending.

The Office Action has required restriction to one of the following inventions under 35 U.S.C. 121:

I. Claims 1-16, drawn to CMP composition, classified in class 252, subclass 79.1.

II. Claims 17-36, drawn to a method of use, classified in class 438, subclass 959.

The Office Action states that the above identified inventions are related as product and process of use. The Office Action asserts that the process for using the product as claimed can be practiced with another materially different product such as a composition without abrasive particles.

The applicants hereby elect, with traverse, invention Group I drawn to a composition. Applicants note that, if and when a product claim of elected Group I is found allowable, the nonelected method claims of Group II that depend from or otherwise include all of the limitations of the allowable product claim should be rejoined and considered. M.P.E.P. § 821.04.

The M.P.E.P. recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for proper restriction between patentably distinct inventions: (a) the inventions must be independent, *and* (b) there must be a serious burden on the examiner in the absence of restriction. See M.P.E.P. § 803. These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.: "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, even if the pending claims are drawn to independent or distinct inventions.

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With respect to the present application and the outstanding restriction requirement, applicants submit that the inventions of Group I and Group II are so related that there will be no serious burden on the Examiner to search and examine all of the subject matter defined by the pending claims at the same time. The Office Action asserts that the method of chemical-mechanical polishing can be achieved by another materially different product such as a composition without abrasive particles. However, claim 1, in Group I, clearly recites in the body of the claim a slurry composition comprising an abrasive comprising α-alumina, a metal ion of a stated concentration and composition, and water. Group II consists of claims 17-36, which are directed to a method of polishing a substrate with the slurry composition of claim 1 in Group I. If claim 1 defines patentable subject matter in view of the prior art, then claims 17-33 necessarily do so as well. Thus, there is significant overlap between the methods of using the slurry composition as defined by the claims of Group II and the slurry composition as defined by the claims of Group I.

In view of the foregoing remarks, applicants respectfully request withdrawal of the restriction requirement, such that all of the subject matter encompassed by the pending claims is considered at the same time.

Respectfully submitted,

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